

Response to Final Action
Application No. 09/643,912
Attorney Docket No.: 001062

REMARKS

Claims 5 and 8 remain for consideration in this application.

Finality of the Office Action

This Office Action has been made FINAL. It is respectfully requested that the finality of this action be withdrawn. Page 6 of the Office Action dated April 15, 2005, states that “[a]pplicant’s amendment necessitated the new ground(s) of rejection presented in this Office Action.” However, we note that the Response filed on February 17, 2005 does not contain an amendment, only remarks. Where not necessitated by amendments, a new ground of rejection should be issued as a non-final Office Action. Specifically, MPEP states:

Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c)... (MPEP 706.07(a)).

Accordingly, since there was no amendment in the Response of February 17, 2005, and the fact that a newly cited reference (Tsukamoto) is applied to reject the claims, it is submitted that a final rejection is improper and that a non-final rejection should have been made. Accordingly, it is respectfully requested that the finality of the current Office Action be withdrawn.

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Claims 5 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kojima (USP 6,253,866) in view of Tsukamoto (USP 5,771,478).

It is the position of the Office Action that **Kojima** discloses the invention as claimed, but does not specifically disclose that the power distribution mechanism comprises a clutch for performing connection or disconnection of the transmission of power between the generator connected to the engine and to the motor. The Office Action relies on **Tsukamoto** for this teaching.

In fact, **Tsukamoto** does not disclose such a clutch, and if such a clutch were included in **Kojima** it would remove the functionality of the invention. Specifically, claim 5 recites:

a clutch for performing the connection or disconnection of the transmission of the power between the generator connected to the engine, and the motor...

Thus, even a combination of **Kojima** and **Tsukamoto** does not disclose, nor suggest, the clutch of claim 5.

Tsukamoto discloses a hybrid vehicle containing a planetary gear set in which the sun gear S is connected to the engine output shaft 12, the planetary carrier C is connected to the transmission output shaft 19, and the ring gear R is connected to the rotor 51 of a generator/motor M1. **Tsukamoto** discloses the use of a clutch as a coupling device in which the ring gear R and sun gear S are locked together. Alternatively, **Tsukamoto** discloses the locking of the ring gear R and carrier C or the carrier C and sun gear S. Please see column 10, lines 52-60. When the clutch is engaged, two of these gear elements are locked together and thus rotate

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together. When the clutch is disengaged, the gears are unlocked and the system works as a conventional planetary gear set, whereby the gears move at different speeds. Thus, there is never a complete disconnection of power between the generator and the motor, only a difference in the force multiplication or division of the permanent connection.

Furthermore, if a clutch was included in **Kojima**, this would remove the functionality of the reference. In **Kojima**, the power distribution mechanism 4 contains a sun gear, planetary gear, a rotary shaft of a planetary carrier, and a ring gear. The sun gear connects to the generator 3, the rotary shaft of the planetary carrier connects to the engine output shaft 1a, and the ring gear connects to the electrically driven motor 2 via the rotary shaft 2a. See column 5, line 62 to column 6, line 6. Based upon the design of **Kojima**, the only place where a clutch could be placed which would connect or disconnect power transmission between the generator 3 and the motor 2 would be between the ring gear and the motor. However, this would serve no purpose. If the clutch were disengaged, power from the engine would not be transmitted to the generator because the gears would "freewheel" (or simply spin). Furthermore, the disconnection would prevent any power from the motor 2 being distributed to the power distributing mechanism 4, and thus the generator 3. Thus, there would be no motivation for one having ordinary skill in the art to add a clutch from **Tsukamoto** to **Kojima**.

Accordingly, it is requested that the rejection of claims 5 and 8 over **Kojima** in view of **Tsukamoto** be withdrawn, since there is no motivation to combine the two references, for the reasons set forth above.

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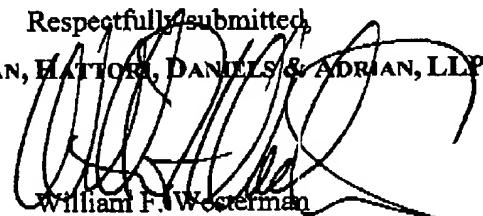
In view of the remarks set forth above, applicants submit that the Examiner's rejection has been overcome. Accordingly, it is respectfully requested that the Examiner withdraw the rejection and allow present claims 5 and 8.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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